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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/595,286	04/05/2006	Frantisek Zak	J187-031 US	6833
21706	7590	08/30/2007	EXAMINER	
NOTARO AND MICHALOS 100 DUTCH HILL ROAD SUITE 110 ORANGEBURG, NY 10962-2100			NAZARIO GONZALEZ, PORFIRIO	
			ART UNIT	PAPER NUMBER
			1621	
			MAIL DATE	DELIVERY MODE
			08/30/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

DETAILED ACTION

Response to Amendment

1. Applicant's amendment filed June 21, 2007 have been fully considered but it does not overcome the rejection of claim 1 under 35 USC 102(b) as being clearly anticipated by JP 05-301884 A. The incorporation of language directed to the process of making the claimed compound, oxaliplatin, in claim 1 does not overcome the above mention rejection. As now amended, claim 1 is a product-by-process claim. It's well settle that in product-by-process claims is the product and not the process that define the invention. See In re Bridgeford, 357 F2d 679, 149 USPQ 55 (CCPA 1955). Here, claim 1 is directed to an "Oxaliplatin with low content of accompanying impurities originating from its preparation". Applicants have further argued, that as amended, the claims are not anticipated or suggested by JP 05-301884 A. Here the main argument from Applicants is that the JP 05-301884 A reference does not discloses or suggest the process of making oxaliplatin as recited in claim 1. However, as noted above Applicants are not claiming the process of making oxaliplatin but rather oxaliplatin itself. Here, the reference teach or disclose an oxaliplatin that appears to be the same, or an obvious variant of, the claimed oxaliplatin even though they are produced by a different process. See In re Marosi, 710 F.2d 799, 218 USPQ 289 (Fed. Cir. 1983) and In re Thorpe, 777 F.2d 695, 227 USPQ 964 (Fed. Cir. 1985). Thus, the rejection is sustained and claim 1 and new claims 5 and 6 are rejected under 35 USC 102(b) as being clearly anticipated by JP 05-301884 A.

Art Unit: 1621

2. Applicant's amendment filed June 21, 2007 overcomes the rejection of claims 1-3 under 35 USC 112, second paragraph. Therefore the Examiner withdraws the rejection.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 2-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase "1: 5 2" appears to be incorrect. According to the original claim 2, the phrase is "1: \leq 2". Please correct.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

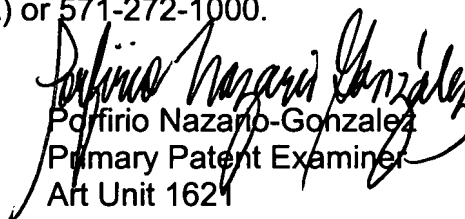
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Art Unit: 1621

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Porfirio Nazario-Gonzalez whose telephone number is 571-272-0641. The examiner can normally be reached on Mon.-Fri. (9:30 AM - 6:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler can be reached on 571-272-0871. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Porfirio Nazario-Gonzalez
Primary Patent Examiner
Art Unit 1621

PNG
August 26, 2007